



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,173	12/04/2003	Douglas Andrew Levin	DUC-002	6696

51414 7590 01/23/2009

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3685

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PatentBos@goodwinprocter.com
hmcpeake@goodwinprocter.com
glenn.williams@goodwinprocter.com

Status of Claims

1. Claims 2-5 and 28 have been examined.

Response to Arguments/Amendments

2. Applicant's arguments with respect to claims 2-5 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s) are:

- receiving a request message comprising a license identifier
- distributing the protectable content and the license identifier

Claim 5 is also rejected as it recites similar language.

Claims 3, 4, and 28 are also rejected as each depends from claim 2.

Claim 28 recites "transmitting a reply message concerning the authenticity of the license." However, claim 2, from which claim 28 depends, is directed to determining the authenticity of the license identifier, therefore it is unclear to one of ordinary skill how the license is authenticated when only the identifier is authenticated.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 2, 4, 5 and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tardo et al., U.S. Patent No. 6,557,105.

As per claims 2, 4, 5 and 28, Tardo et al. teach a method comprising:

- accessing a license profile associated with the protectable content, the license profile identifying attributes affecting at least one operation of the protectable content (column 6, lines 30-38; column 7, lines 22-40)
- accessing a content identifier representing the protectable content, wherein the protectable content corresponds to at least one of a software element, multimedia presentation, a video segment, an audio segment, a textual representation, a work of art, a visual representation, a technological, know-how, a business know-how, and a contract right- associated with a license (column 5, lines 3-14 and 25-40; column 6, lines 30-40)
- computing a license identifier based, at least in part, on the accessed license profile and the accessed content identifier, the computed license identifier comprising information concerning the license associated with the protectable content (signed encrypted license token 122) (column 5, lines 50-67)
- storing the license identifier (column 5, lines 45-56)
- transmitting the license identifier over a network; (column 7, lines 55-60)
- receiving a request message over a network to authenticate the license identifier (column 7, lines 40-45)

Art Unit: 3685

- comparing the received license identifier with a corresponding stored license identifier to authenticate the license identifier (column/line 7/64-8/48)
- transmitting a reply message concerning the authenticity of the license

Regarding the license identifier, it has been held that “[l]anguage that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106 II C), therefore what the license is intended for (i.e. for subsequent distribution with the protectable content) will not distinguish the claims from the prior art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tardo et al., U.S. Patent No. 6,557,105.

As per claims 2, 4, 5 and 28, Tardo et al. teach a method comprising:

- accessing a license profile associated with the protectable content, the license profile identifying attributes affecting at least one operation of the protectable content (column 6, lines 30-38; column 7, lines 22-40)
- accessing a content identifier representing the protectable content, wherein the protectable content corresponds to at least one of a software element, multimedia presentation, a video segment, an audio segment, a textual representation, a work of art, a visual representation, a technological, know-how, a business know-how, and a contract right- associated with a license (column 5, lines 3-14 and 25-40; column 6, lines 30-40)
- computing a license identifier based, at least in part, on the accessed license profile and the accessed content identifier, the computed license identifier comprising information concerning the license associated with the protectable content (signed encrypted license token 122) (column 5, lines 50-67)
- storing the license identifier (column 5, lines 45-56)
- transmitting the license identifier over a network; (column 7, lines 55-60)
- receiving a request message over a network to authenticate the license identifier (column 7, lines 40-45)

- comparing the received license identifier with a corresponding stored license identifier to authenticate the license identifier (column/line 7/64-8/48)
- transmitting a reply message concerning the authenticity of the license

Regarding the license identifier, it has been held that “[l]anguage that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106 II C), therefore what the license is intended for (i.e. for subsequent distribution with the protectable content) will not distinguish the claims from the prior art.

As per claim 3, Tardo et al. is directed to enabling software options (column 4, lines 14-53) therefore, as open-source software is also software a predictable result (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)) would have been to apply the teachings of Tardo et al. to open source software (e.g. JVM, JAVA).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

Art Unit: 3685

<http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685